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09/462,502	01/24/2000	YASUO KONDO	10641-0001-3	5164

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26  
EXAMINER

SIMONE, CATHERINE A

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/462,502

Applicant(s)

KONDO ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 1,3,5-17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Withdrawn Rejections*

1. The 35 U.S.C. 102 rejection of claims 1, 3, 5, 12-17 and 19 of record in Paper #23, Pages 3-4, Paragraph #5 has been withdrawn due to the Applicant's argument in Paper #24.
2. The 35 U.S.C. 103 rejection of claims 6-11 of record in Paper #23, Pages 4-5, Paragraph #7 has been withdrawn due to the Applicant's argument in Paper #24.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. **Claims 1, 3, 5, 12-17 and 19** are rejected under 35 U.S.C. 102(e) as being anticipated by Totani et al. (5,865,461).

Regarding **claims 1, 13, 14 and 16**, Totani et al. discloses a panel for an airbag of an automobile formed by integrally two-color molding a cover body (Fig. 1, #12) made of a first synthetic resin with a main body (Fig. 1, #11) made of a second synthetic resin which is harder than the first synthetic resin material (see col. 2, lines 50-53), the panel comprising: a joint portion (Fig. 1, #17) joined with the cover body (Fig. 1, #12) provided around an opening portion (Fig. 1, above #2) formed in the main body (Fig. 1, #11), wherein the joint portion constitutes an overlapping portion (Fig. 1, #17) in which an outer peripheral edge of the cover body (Fig. 1, #12) is overlapped as being arranged on the inner side of an opening edge of the main body and the overlapping portion is welded together in two-color molding in the main body with the cover body; and a deformation restricting portion (Fig. 1, above #11) provided at the outer peripheral edge of the cover body and engaged with a mold face, wherein the main body (Fig. 1, #11) includes an opening portion (Fig. 1, above #2) which is closed by the cover body (Fig. 1, #12).

Regarding **claim 3**, note a concavo-convex portion (Fig. 1, #17c) having a downwardly convex shape is formed on a lower face of the main body (Fig. 1, #11) in the overlapping portion (Fig. 1, #17). Regarding **claim 5**, note a surface of a periphery of the cover body has a step portion (Fig. 1, #14a) adjacent to the rear surface of the cover body and facing the edge of the opening portion (Fig. 1, above #2) of the main body, thereby, a groove portion (Fig. 1 and 17, #14) having a closed curve shape is formed in a boundary portion of an end portion of the opening portion of the main body (Fig. 1, #11) in the cover body (Fig. 1, #12), and a first wall portion which is thin (Fig. 1, #13) and which ruptures and a second wall portion (Fig. 1, #16) which is at least 1.5 times as thick as the first wall portion and which does not rupture at an operating time of the airbag are formed along the groove portion (Fig. 1, #14) in the cover body in a single line shape.

Regarding **claims 12 and 19**, note a rib projecting (Fig. 1, #5c) into the second wall portion and connected to the airbag case through a connecting member (see col. 7, lines 52-55). Regarding **claims 15 and 17**, note the deformation restricting portion is constituted of a convex strip having an angular cross section (Fig. 1, above #11).

Regarding **claims 1 and 14**, process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation “welded together in two-color molding” (claim 1) and “being formed by two-color molding” (claim 14) are methods of production and therefore do not determine the patentability of the product itself.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 6-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Totani et al. (5,865,461).

Totani et al. discloses a panel for an airbag of an automobile formed by integrally two-color molding a cover body (Fig. 1, #12) made of a first synthetic resin with a main body (Fig. 1, #11) made of a second synthetic resin which is harder than the first synthetic resin material (see col. 2, lines 50-53), the panel comprising: a joint portion (Fig. 1, #17) joined with the cover body (Fig. 1, #12) provided around an opening portion (Fig. 1, above #2) formed in the main body (Fig. 1, #11), wherein the joint portion constitutes an overlapping portion (Fig. 1, #17) in which an outer peripheral edge of the cover body is overlapped as being arranged on the inner side of an opening edge of the main body and the overlapping portion is welded together in two-color molding in the main body with the cover body. Totani et al. also discloses a first wall portion (Fig. 1, #13) and a second wall portion (Fig. 1, #16) as well as a groove portion (Fig. 1, #14). However, Totani et al. fails to disclose the first and second wall portions being of different shapes i.e. a quadrilateral, two quadrilaterals, one transversal line, one longitudinal line or H-shaped.

Normally, it is to be expected that a change in shape of the first and second wall portions would be an unpatentable modification. Under some circumstances, however, changes such as

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shape may impart patentability to a product if the particular shape claimed produces a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. *In re Dailey et al*, 149 USPQ 47 CCPA 1966.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the first and second wall portions noted in Totani et al. to a longitudinal line, a transversal line, a quadrilateral, two quadrilaterals or an H-shape. One skilled in the art would have been motivated to do so in order to form a panel for an airbag, since it has been held that the change in form or shape of the thin and non-thin wall portion would be an unpatentable modification absence of showing unexpected results.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 3, 5-17 and 19 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Allowable Subject Matter***

8. Claim 20 is allowed. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach or suggest the recited "interrupting a portion between a first cavity portion for forming a first member and a second cavity portion for forming a second member by allowing the core to project and contact an opposite one of the male or female die" and the recited "forming a communicating portion between the first and second cavity portions by retreating the core" in claim 20.

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*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703)605-4297.

The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Catherine Simone  
Examiner  
Art Unit 1772  
August 21, 2003



HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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8/22/03